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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,827

04/15/2004

Claude Ray

7739

33376

7590

04/04/2006

KENNETH L. TOLAR
2908 Hessmer Avenue
Metairie, LA 70002

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,827

Applicant(s)

RAY ET AL.

Examiner

David C. Reese

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17, 19-20 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 1/24/2006.

Status of Claims

[1] Claims 6, 11-20 are pending.

Election/Restrictions

[2] This application contains claim 6 drawn to a species nonelected without traverse in Paper No. 4/14/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

[3] The drawing(s) were previously objected for informalities. In view of Applicant's remarks, all previous objection(s) to the drawings have not been withdrawn. In short, the elected drawings (3-5, and 6) were originally objected to as they failed to show the claimed subject matter. Applicant claims that he has found no requirement that the claimed features must be shown in an "elected" drawing. The applicant further states that he elected a species as defined by the claims. This is simply not the case. In a restriction requirement; specifically a species restriction, the species is defined by the figures, not the claims. First, the applicant must elect a species based on a set of figures, and then select a listing of all claims readable on said set of figures. Examiner directs applicant's attention to the restriction requirement 3/8/2005.

Claim Objections

[4] Claim 6 is objected to because of the following informalities: It is dependent upon a canceled claim (claim 1). Appropriate correction is required.

Claim Rejections - 35 USC § 112

[5] Applicant failed to properly address the rejections under 35 USC § 112 to the Claims in the amendment filed 1/24/2006. Accordingly, the Examiner has not withdrawn the 35 USC § 112 rejections. Claim 5 was originally rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicant regards as the invention. This was primarily due to statements from claim 5 that read upon a non-elected set of figures, due to the species restriction. Applicant has refuted such a rejection via the arguments concerning the objection to the drawings. In response, the applicant can direct their attention to the drawings section above, so thus, new claims 15 and 16 are therefore rejected for the same reasons as original claim 5.

Secondly, claim 10 was originally rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter the applicant regards as the invention, since the statement “slot positioned beneath said lip” was slightly indefinite. Applicant responded to said rejection by stating that the claim correctly defines the subject matter. Examiner disagrees. Applicant based said refutement on statements that are not currently stated by the instant claim. For example, the applicant states in his arguments that “the slot is positioned beneath said lip when the bezel receives the neck to allow the clip to be positioned beneath the lip to prevent separation of the bezel and the neck.” This, however, is not what is claimed; and thus, the rejection with regard to originally claim 10, now claim 18 is still maintained by examiner. The ambiguity to the claim still resides in the statement failing to distinctly point out that the slot is found in the bezel, and that only when the bezel receives the neck in a particular configuration is the slot, of the bezel, positioned beneath the lip of the neck.

Claim Rejections - 35 USC § 102

[6] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[7] Claim 11 is rejected under 35 U.S.C. 102(b) as clearly anticipated by Blume, US-1,025,447, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Blume is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 11, Blume teaches of a jewelry item with a rotating gemstone (see figure below) comprising:

a substantially hollow housing (1) having an upper end and a lower end;

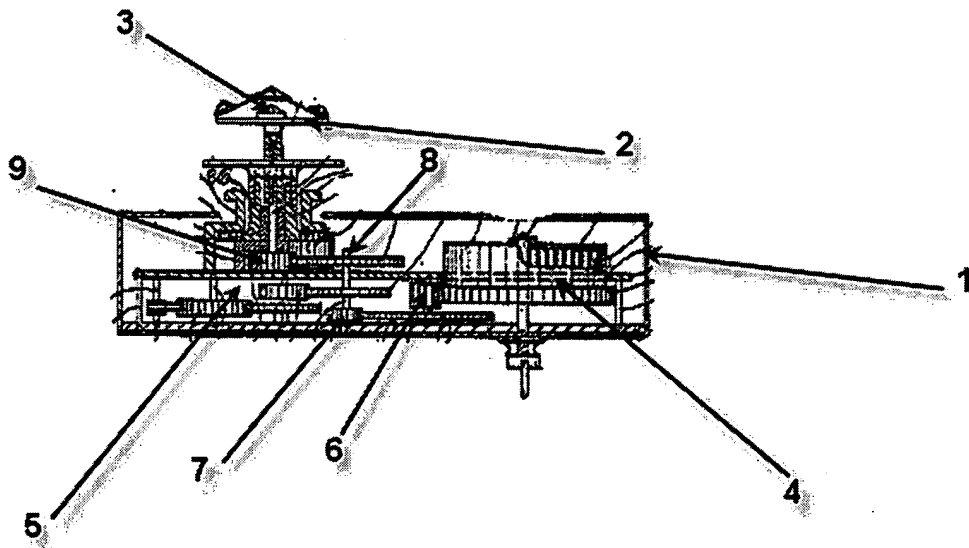
a bezel (2) rotatably mounted on the upper end of said housing;

a gemstone (3) mounted on said bezel (2);

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a motor means (4) received within said housing (1) for automatically rotating said bezel and said gemstone (3) at a predetermined, discrete speed (after the winding of the spring, the motor then actuates the gears at a predetermined, discrete speed);

a gear assembly (5) including a plurality of gears (6-9) driven by said motor means (4) and operably connected to said bezel (2), said gears (6-9) having a predetermined, precise gear ratio for rotating said bezel at a discrete speed, wherein said gear assembly (5) further includes a drive gear (6) connected to said means (4); and an intermediate gear (7) engaging said drive gear (6), said intermediate gear (7) having an upper surface with a sprocket (8) extending therefrom, and a bezel gear (9) connected to said bezel (2) and engaging said sprocket (8).



Claim Rejections - 35 USC § 103

[8] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[9] Claims 11-12, 17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese, US- 4,764,850, in view of Hartman, US-5,971,829.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 11, Albanese teaches of a jewelry item with a rotating gemstone comprising:

a substantially hollow housing (22) having an upper end (25) and a lower end (24);

a bezel (42) rotatably mounted on the upper end of said housing (via 18);

a gemstone (20) mounted on said bezel (42);

a motor means (30) received within said housing (22) for automatically rotating said bezel and said gemstone at a predetermined, discrete speed;

a gear assembly (32, 33) including a plurality of gears (32, 33) driven by said motor means (30) and operably connected to said bezel (42), said gears (32, 33) having a predetermined, precise gear ratio for rotating said bezel at a discrete speed,

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a drive gear (32) connected to said means (30); and a bezel gear (33) connected to said bezel (42).

The difference between the claim and Albanese is the claim recites: and an intermediate gear engaging said drive gear, said intermediate gear having an upper surface with a sprocket extending therefrom, with said bezel gear engaging said sprocket. Hartman discloses a motorized device including a motor means and gear assembly similar to that of Albanese. In addition, Hartman further teaches of a drive gear (28a) connected to said means (24); an intermediate gear (28b) engaging said drive gear (28a), said intermediate gear (28b) having an upper surface with a sprocket (26) extending therefrom and a bezel gear (28c) connected to said bezel (32 via 30). It would have been obvious to one of ordinary skill in the art, having the disclosures of Albanese and Hartman before him at the time the invention was made, to modify the gear structure of Albanese to incorporate an intermediate gear as in Hartman. One would have been motivated to make such a combination because having such a number of gears in such an orientation allows for a reducing gear set that regulates the revolution output properly and as stated by Hartman from column 3, 56, “produce a proper torque to turn...”

Re: Claim 12, Albanese teaches wherein said discrete speed is between 2 and 4 revolutions per minute (from column 3, line 12, “gearing to a range of 2 rmps to 3 rpms”).

Re: Claim 17, Hartman further teaches comprising a lower spacer plate (21b) superimposed on said driver gear (24), said spacer plate (21b) having an aperture (36b) with said drive gear received therein (24).

Re: Claim 19, wherein said lower spacer plate includes a depression thereon that receives said intermediate gear (It would have been an obvious matter of art recognized equivalence to

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create a depression or another hole for the intermediate gear to be positioned in/on, as the pertinence behind the intermediate gear is its position between both the drive gear and bezel gear as to properly provide the movement upwards; Applicant has also not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Albanese in view of Hartman.

Re: Claim 20, further comprising an upper spacer plate (21a) superimposed on said lower spacer plate (21b) with said intermediate gear (28b) positioned therebetween.

[10] Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese, US- 4,764,850, in view of Hartman, US-5,971,829, and in further view of Marshall, US- 6,209,242.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 13, Albanese in view of Hartman teaches of the above claims.

The difference between the claim and Albanese in view of Hartman is the claim recites that the motor means includes a quartz movement motor. Marshall discloses a rotating display for jewelry (col. 2, lines 50-54) similar to that of Albanese in view of Hartman. In addition, Marshall further teaches of using a quartz movement motor for the motor means of the instant invention. It would have been obvious to one of ordinary skill in the art, having the disclosures of Albanese in view of Hartman and Marshall before him at the time the invention was made, to

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modify the motor means of Albanese in view of Hartman to include a quartz movement motor as in Marshall. One would have been motivated to make such a combination because first, such a motor means is extremely old and well known in the jewelry art, especially with regard to watches and other rotational devices. There are many reasons to use a quartz movement motor for motor means of a given rotational device. Some example of which, as taught by Marshall, in col. 1, include a need for a rotating display which can be manufactured and utilized at a low cost in order to employ a multiplicity of such displays in a jewelry case or window. Marshall also states that there is further a need for a rotating display which takes advantage of piezo electricity and which can be aesthetically pleasing in a jewelry case or window. Marshall further teaches that solar cell panels (such as the one taught by Albanese) are not aesthetically pleasing enough for the desired uses. Finally, Marshall also teaches another advantage of using a quartz movement motor is that the accuracy of movement created by the quartz oscillators may be taken advantage of in motorized jewelry displays by synchronizing displays.

Re: Claim 14, Marshall teaches wherein said motor means further comprises an integrated circuit (col. 2, beginning with line 61) [for controlling speed and torque of said quartz movement motor].

Allowable Subject Matter

[11] Claims 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As for Claim 18, the prior art, incorporating other corresponding limitations as set forth above, does not teach of the structural/functional relationship between the bezel, the slot at the

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bottom of the bezel, the lip and neck; whereby when the bezel is overtop the shroud (lip and neck) the two pieces are held together by a clip that passes through the slot of the bezel and attaches to the neck of the shroud.

Response to Arguments

[12] Applicant amendment filed 1/24/2006 regarding rejections under 35 U.S.C. 102 have been fully considered. Due to the amendment to the claims (claim 11 being a combination of original claims 1, 2, and 7); as well as new claim 14, the prior art of Albanese and Marshall, individually, fail to further anticipate. Accordingly, the Examiner has withdrawn all previous 102 (b) rejections over both Albanese and Marshall. New grounds of rejection, however, have been issued under 35 U.S.C. 102 under Blume (see Claim 1 above), and all arguments are considered moot to said new grounds of rejection.

[13] Applicant's arguments filed 1/24/2006 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. Applicant primarily argues that Hartman is nonanalogous subject matter since he teaches of a motorized ice cream cone, which he states is in no way related to jewelry. In response to Applicant's argument that Hartman is nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174. In this case, it is two fold; and to begin, since both devices use a motor means and gear assemblies to rotate an article, both references are thus considered within the same field of endeavor. Second, it will be also

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apparent to one that the reference has been used due to its reasonable pertinence to the particular problem with which the inventor was involved. The primary purpose of using the reference of Hartman was to show the prevalence of an embodiment using different gears within a gear assembly to rotate a given device. Rotation of a device including the various gears and motor means is not a novel concept; as in the instant case, one would only have to substitute a gemstone into Hartman to gain the claimed subject matter of the given application. Applicant states that the examiner has not presented a convincing line of reasoning as to why the applicant could readily combine an ice cream holder with a spring motor operated jewelry display to form the instant invention. Hartman, however, discloses a motorized motor, not a spring motor, and as stated above, it would be completely obvious to one to substitute any article, including one of a jewelry item, to the rotational display taught by Hartman and Marshall.

Applicant continues to state that the applicants' gear system and drive motor assembly required many years of design to achieve...etc. This is irrelevant as it is solely the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Once again, the examiner believes it is pertinent to point out that in the instant case, the most novel aspect of the given invention does not appear to be the fact that what is being rotated is the gemstone; the examiner suggests that the structure of the device that helps rotate and hold said gemstone be claimed more appropriately. Lastly, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification

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be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re* McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In *re* Bozek, 163 USPQ 545 (CCPA) 1969.

It is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. *See In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *See In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Please also note the additional notice of reference cited.

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Conclusion

[14] Applicant's amendment (new claim 11 being a combination of original claims 1, 2, and 7); as well as new claim 14, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

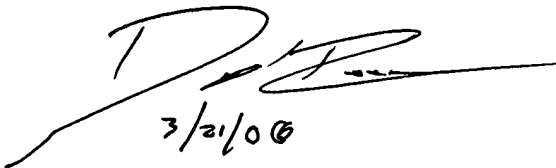
[15] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

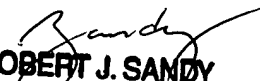
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese
Assistant Examiner
Art Unit 3677

DCR



3/21/06



ROBERT J. SANDY
PRIMARY EXAMINER